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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,818	01/21/2005	Koji Yamada	12065-0020	2397
22902 7590 09/24/2008 CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005				
EXAMINER YANG, JIE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
09/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/521,818

Applicant(s)

YAMADA ET AL.

Examiner

JIE YANG

Art Unit

1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Roy King/
Supervisory Patent Examiner, Art Unit 1793

JY

Continuation of 3. Note: The amended feature in claim1 : "...a platinum group element-containing substance including spent petrochemical type catalyst or spent vehicle exhaust gas purification catalyst..." in the proposed claim1 was not contained in the finally rejected claim. They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because: the Applicants argue: the prior art cited by the Examiner does not establish a prima facie case of obviousness against any of claims 1, 3, and 4 for the following reasons:

- 1) JP'322 does not teach the steps of ascertaining and discharging as now found in claim 1. There is absolutely no basis to make the leap-to allege copper in the molten slag is taught to be a result effective variable in JP'322 based on the mere fact that JP'322 reports on the levels of copper and platinum.
- 2) Jones et al (US'302) does not teach the ascertaining and discharging steps as alleged by the Examiner; Jones does not teach the analyzing the copper content of the molten slag in the furnace and using this information to control the discharge of the molten slag from the electric furnace. The mere fact that Jones may conduct analyses of the concentrate and slag does not equate to the claimed processing steps. Jones says absolutely nothing about monitoring.
- 3) Jones does not teach a relationship between PGMs and copper content in the slag; Jones does not teach that the diameter of the source material is a resultive variable; Jones does not teach the limitations of Claim 4.

In response:

Regarding arguments 1 and 2, the Examiner disagrees with the applicants' arguments. As pointed out in the previous office actions marked 06/05/2008 and 11/28/2008, JP'322 teaches the relationship between copper content of the molten slag and the recovery rate of Pt (table 1-2 of JP'322), while US'302 teaches the analyses of the original concentrate, roasted concentrate, and slag (Col.18, line 31 to Col.20, line 53 of US'302). It is the Examiner's position that the analyses of JP'322 and US'302 are monitoring processes and it would have been obvious to one skilled in the art to use these data to control the Pt recovery process.

Regarding argument 3, the Applicants do not argue the combinations of the cited references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, US'305 in view of JP'322 and US'302 is applied on claims 1 and 4, and US'305 in view of JP'322 and US'302, and further in view of US'933 is applied to the limitation of claim 3. US'302 teaches the analyses of the original concentrate, roasted concentrate, and slag (Col.18, line 31 to Col.20, line 53 of US'302); US'302 teaches the DC arc furnace can handle fine feed materials, typically sized below 3 mm, which makes it be suitable for coupling to a fluidized-bed roaster (Col.6, line 18-33 of US'302); and US'302 teaches forming particles of copper/nickel alloy by at least one of water atomization, granulation, or crushing and milling (Claim 19 of US'302) in order to obtain a suitable particle size (Col.6, lines 18-33 of US'302). The detail discussion and motivation to combine the prior arts can refer to the the previous office actions marked 06/05/2008 and 11/28/2008.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.